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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,646	07/06/2005	Alain Geloen	1759.203	3858
23405	7590	11/07/2006		
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203			EXAMINER CRANE, LAWRENCE E	
			ART UNIT 1623	PAPER NUMBER

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/541,646	GELOEN ET AL.	
	Examiner	Art Unit	
	L. E. Crane	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on July 6, 2005 (prelim. amdt.).
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 July 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/06/2005</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

The Abstract of the Disclosure is objected to because it does not meet the requirement of the MPEP for US application. Correction is required. See MPEP 608.01(b).

The instant abstract is incomplete because it fails to provide a complete description of the claimed invention. Examiner suggests that an expanded abstract should include a generic chemical structure of the compounds referred to in the present abstract.

Applicant is reminded of the proper content of an Abstract of the Disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

This application has been filed with informal drawings acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

The instant drawings have numerous machine marks and extraneous marks which make the written portions of the figures hard to read in some instances.

No claims have been cancelled, claims **1-3 and 5-19** have been amended, the disclosure has been amended at page 1, and no new claims have been added as per the preliminary amendment filed July 6, 2005. One Information Disclosure Statement (1 IDS) filed July 6, 2005 has been received with all cited references and made of record. A

Claims **1-19** remain in the case.

Note to applicant: when a rejection refers to a claim **X** at line **y**, the line number "y" is determined from the claim as previously submitted by applicant in the most recent response including ~~lines deleted by line through~~.

35 U.S.C. §101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

Claims **1-5** are rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. §101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App.6+, 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149, 149 USPQ 475 (D.D.C. 1966).

Applicant is referred to each of claims **1-5** wherein the claim is introduced at line one by the term "Use." Examiner suggests substitution of an alternative term and a more complete description of the process step or steps implied by the noted term in any amendment of the noted claims.

Claims **1-19** are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant specification discloses test data which indicates changes in lipid composition in test tissues, but fails to provide any data indicated that these test results may be believably extrapolated to the effective treatment of "cellulite," or reduction in the external manifestation thereof, in hosts presenting with "cellulite," a term defined in Taber's Cyclopedic Medical Dictionary at page 372 (19th Edition, 2001) as "subcutaneous deposit of fat, especially in the buttocks, legs, and thighs." Therefore, the written description is deemed to have failed to describe how to effectively treat hosts suffering from "cellulite."

Claims **6-18** are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims **1 and 6-7** the term "glucose" is incorrect because the noted term refers to a compound, not a substituent. Examiner suggests substitution of the term -- 1-glucosyl -- as one possible solution.

In claims **6-18** the term "composition" is a term of art requiring the claim to list at least two different and distinct chemical components. In each of the noted claims only a single chemical constituent has been described. Applicant is respectfully requested to identify each and every additional chemical constituent present if a composition is being claimed or to change to claims to -- compound -- claims, or to make other appropriate changes; e.g. amend claim **6** to include all of the variables added in dependent claims **7-18** at least in generic form.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, dependent claims **7 and 8** recite the broad

Art Unit: 1623

recitation "comprises," and independent claim 6 recites "containing" which is the narrower statement of the range/limitation.

Examiner suggests that independent "composition" claims (claim 6) are properly drafted with the term of art "comprising" to insure the ability to defend the instant subject matter broadly against infringement, but the when reference is made to individual compounds in claims 7 and 8, narrow language is necessary because the term "comprises" implies incorrectly that the specifically named compounds are not entirely defined by the structures defined in claim 6, i.e. that additional subject matter is "included" but not defined by claims 7 and 8. See also claims 11, 14-16 and 18 wherein the same error also occurs.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent."
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."
- (e) the invention was described in
 - (1) an application for patent described under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application filed under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a)."
- (f) he did not himself invent the subject matter sought to be patented."

Claims 1-6 and 8-19 are rejected under 35 U.S.C. §102(b) as being anticipated by Baskys '837 (PTO-1449 ref. AA).

Applicant is referred to claims 1, 4 and 8 wherein the instant active ingredient (cirsimarinin) and a method of transdermal adminstraton have been disclosed which disclosure

anticipates instant composition claims **6-18** and inherently anticipate instant method claims **1-5 and 19**.

Claims **1-19** are rejected under 35 U.S.C. §102(b) as being anticipated by **Hasrtat et al.** (PTO-1449 ref. **CB**).

Applicant is referred to Table 2 at page 640 wherein the instant active ingredients (“cirsimarin” and “cirsimaritin” are at the top of the list of compounds) have been disclosed which disclosure anticipates instant composition claims **6-18**. In addition, the disclosure of biological activity at column 1 at page 641 inherently anticipates instant method claims **1-5 and 19**.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §§102(f) or (g) prior art under 35 U.S.C. §103(a).

Papers related to this application may be submitted to Group 1600 via facsimile transmission (FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone number to FAX (unofficially) directly to Examiner's computer is 571-273-0651. The telephone number for sending an Official FAX to the PTO is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **571-272-0651**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. S. Anna Jiang, can be reached at **571-272-0627**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is **571-272-1600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status Information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see < <http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

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11/05/2006



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